

REMARKS

1. Upon entry of the present Amendment, Claims 1-21 are present in the case. In view of the present remarks, applicants request entry of the present response, reconsideration and withdrawal of the rejections and objections of the pending office action, and allowance of all claims present in the case at an early date.

2. The rejections and objections of the office action of February 25, 2003 have been withdrawn in view of the arguments of the response of May 27, 2003. New rejections and objections are imposed by the pending office action, based on newly cited United States patent references.

3. Claim 1 is rejected "under 35 U.S.C. 102(e) as being anticipated by Goldberg et al (6,244,730) in further view of Esakoff et al (6,092,914)." Clearly, the rejection is under 35 U.S.C. 103(a) since the combination of two references forms the basis of the rejection. Further, the argument presented by the office action in regards to this rejection is not an argument for anticipation but for obviousness.

4. Claim 20 is rejected under 35 U.S.C. 102(e) as anticipated by Labrum (4,210,955).

5. Claims 2-10, depending directly or indirectly from Claim 1, are objected to as being dependent upon a rejected base claim, but are indicated as being allowable if rewritten in independent form.

6. Applicants note with appreciation the repeated indication of allowance of Claims 11-19 and 21, including independent Claims 11, 16 and 21. Again, applicants agree that the claims are allowable but question the analysis given in item 7 of the office action that supposedly sets out the reasons the claims are allowable. This analysis includes nothing more than a recitation of the contents of the claims and the statement that the prior art does not teach those contents. Some of the wording of the claim contents is in bold face print, but no explanation of the significance, if any, of the bold face print is given. Applicants are at a loss as to the meaning intended by the office action, and again state that if the office action is going to give reasons for the allowance of any claims then the reasons should be explicitly stated.

7. In considering the new rejection of Claim 1 under 35 USC 103(a), applicants first note the requirements for making such a rejection.

8. The examiner has the burden of presenting a *prima facie* case of unpatentability, which requires the examiner to produce a factual basis for

rejections of claims under 35 USC §103. If that burden is met, then the burden of going forward with evidence shifts to the applicant. See, e.g., In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785 (Fed. Cir. 1984); In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent". In re Oetiker, *supra* at USPQ2d 1444; see also In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998).

9. A rejection for obviousness based on a combination of references requires that there must have been a reason, suggestion, or motivation to lead an inventor to combine those references. Such a suggestion may come expressly from the references themselves, from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem, or from the knowledge of those skilled in the art that certain references are known to be of special interest in the particular field. See, e.g., In re Fine, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397, 1398, 1399 (Fed. Cir. 1989); In re Oetiker, *supra* at USPQ2d 1446; Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 37 USPQ2d 1626, 1629, 1630, (Fed. Cir. 1996); In re Rouffet, *supra* at USPQ2d 1456 and 1458; Al-Site, Corp. v. VSI International, Inc., 174 F.3d 1308, 50 USPQ2d 1161, 1170 (Fed. Cir. 1999); In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); Robotic Vision Systems, Inc. v. View Engineering, Inc., 51 USPQ2d 1948, 1954 (Fed. Cir. 1999).

10. "Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. [Citation omitted.] Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure". [Citation omitted.] In re Vaeck, 977 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

11. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, *supra* at USPQ2d 1600; see also Gore & Associates, Inc. v. Garlock, Inc., 721 Fed.2d 1540, 1553, 220, USPQ 303 (Fed. Cir. 1983); Interconnect Planning Corporation v. Feil, et al., 774 Fed.2d 1132, 227 USPQ 543, 551 (Fed. Cir. 1985); In re Gorman, 933

Fed.2d 982, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 USPQ2d 1551, 1554, (Fed. Cir. 1996); In re Rouffet *supra* at USPQ2d 1457; ATD Corp. v. Lydall, Inc., 159 F.2d 534, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

12. "The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner. The 'prima facie case' notion, the exact origin of which appears obscure [citation omitted], seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument." In re Oetiker, *supra* concurring opinion at USPQ2d 1447; *see also* In re Dembiczak, *supra* at USPQ2d 1618.

13. Even if a factual finding of the level of ordinary skill in the art has been made, rarely does such a finding itself provide the missing knowledge or prior art to complete the presentation of a case of obviousness. *See, e.g., Al-Site Corp. v. VSI International, Inc.*, *supra* at USPQ2d 1171. It is insufficient to invoke a high level of skill to provide the necessary motivation to combine cited references in an effort to find the claimed invention as obvious. Rather, the rejection must explain the specific understanding or principle within the knowledge of one of ordinary skill in the art, who does not possess knowledge of the claimed invention, that would motivate such a person to select the references and combine them to make the claimed invention. *See In re Rouffet*, *supra* at USPQ2d 1458 and 1459.

14. The office action has failed to show (a) that a combination from the two cited references can be formed that would be consistent with the original operation of the apparatus of the main reference, (b) that such a combination would provide the present invention as claimed, and (c) that there is any suggestion or inspiration in either of the references that would lead one to make the combination of parts that the office action relies on for the rejection. In short, the office action has failed to make a *prima facie* case for the rejection of Claim 1.

15. In addition to the failure of the rejection of Claim 1 under 35 USC 103(a) for lack of a *prima facie* case, applicants note that the office action also fails to provide prior art that discloses all of the elements of the claim. A fundamental cause for this failure is the fact that each of the two references relied on discloses a type of light projector, and neither of the references discloses a housing or a mounting assembly as recited in Claim 1. The office action misreads Goldberg as if such a housing and mounting assembly are present, but identifies parts of the spotlight assembly as the mounting assembly on which the light projector is

supposed to be mounted, and as the housing that is supposed to receive the mounting assembly. Further, the office action is remiss in identifying parts by their reference numbers as if the parts were something other than what they are.

16. Four items in Goldberg are identified by the office action as allegedly supplying elements of the claim. In particular, item 10 of Goldberg is identified as supplying the housing of the claim. However, item 10 is not a housing but the entire "spotlight assembly 10, including a spotlight 12 and a removable extender 40." (column 2, lines 39 and 40) Nothing is identified in Goldberg as providing a mounting assembly or its frame, but an annular flange of the claim is supposedly found at 16, which is a "lens frame or shell." (column 2, lines 45 and 46) The extender 40 is identified as the claimed two retainer walls extending perpendicularly to the plane of the flange. As claimed, the retainer walls are parallel to each other on opposite sides of the opening defined by the flange in the claim. However, "the extender 40 is configured as a right circular cylinder and includes a cylinder 41 and a mounting bracket 44." (column 2, lines 63-65) The cylinder 41 includes a sidewall 42 that includes "a first shell 42(a) affixed to mounting bracket 44 (e.g., by welding) and a second bracket 42(b) which is movably affixed to first shell 42(a) by a hinge 45." (column 3, lines 29-31) Thus, what the office action asserts are two retainer walls that are supposedly parallel to each other are in fact two parts of a cylinder. Further, the claim requires a contour light projector that is mounted on the mounting assembly. Thus, in the scheme of the office action, the contour light projector would be mounted on the lens frame 16 or the cylinder 41. However, for the contour light projector the office action identifies item 76, which is described in the following sentence at column 3, lines 33-35: "Second shell 42(b) is openable with respect to first shell 42(a) to form an opening 76 in the sidewall 42 for insertion or removal of one or more light guides 60."

17. Claim 1 defines a lighting system comprising a housing; by contrast the office action identifies the entire spotlight assembly 10 as the housing. The claim describes the mounting assembly as comprising a frame having an annular flange and the two mutually parallel walls; instead, the office action provides a lens frame 16 and a separate cylinder 41. The claim requires a contour light projector mounted on the mounting assembly; mysteriously, the office action identifies an opening that occurs when the second shell 42(b) of the cylinder sidewall 42 is swung open relative to the first shell 42(a). The office action fails to identify a single item in Goldberg that supplies an element of Claim 1. The reason for this failure is primarily that Goldberg discloses "a spotlight assembly 10, including a spotlight 12 and a removable extender 40" (column 2, lines 39 and 40), and not the

lighting system of Claim 1, even without the light beam contour mask. Adding the shutter blades 50 of Esakoff would thus not result in a combination that would anticipate the claim. The rejection of Claim 1 fails and should be withdrawn.

18. In the new rejection of Claim 20 the office action merely restates the text of the claim in asserting that Landrum discloses all of the elements of that claim, and refers only to Figs. 1-3 and item 10 of Landrum as the ring. There is no identification of any other item in the Landrum disclosure as providing any other element of the claim. In order to establish a *prima facie* case of anticipation under 35 USC 102(b), the office action must show that each and every element as set forth in the claim is found in the cited reference. (MPEP 2131) In this case, the office action merely attempts to do so with respect to the claimed ring, and leaves the applicants to scramble through the reference in their own quest to find the supposed anticipated elements. Applicants cannot be expected to rebut a rejection based on an argument that is not recited. Nevertheless, in order to move this case to conclusion, the applicants examine the Landrum reference to show that it does not anticipate the claimed invention.

19. Note first that all four drawing views of Landrum are of the same disclosure. Item 10 is identified as a support housing, which the office action claims discloses the ring of the claim. Four shutter blades are presented as a pair of opposing blades 15 and a second set of opposing blades 16, with the blades arranged so that one set is rotated 90° relative to the other set. See column 2, lines 39-48. Each of the blades 15 has a single elongated neck 15a, and each of the blades 16 has a single elongated neck 16a. A handle 25 is attached to the end of each of the necks 15a and 16a. The blades are moved individually by the necks, or the handles 25. See column 2, line 49 through column 3, line 11, and Figs. 1-4. Each of the blades 15 and 16 has a "straight edge portion 28" at the ends of which are "short straight portions 29 sloped relative to the straight portion 28." (Column 3, lines 31-36) The end portions 29 are sloped backwards from the line of the straight portion 28 in each case. See Figs. 2 and 3. Thus, each blade of the reference may be described as having three edge segments combined to form a convex edge assembly, but not as having the concave edge claimed.

20. It is crystal clear from the text and the drawings that Landrum does not disclose shutter blades "wherein each blade has a concave edge toward the central axis of the holding ring, and wherein ... one blade has two tabs extending laterally in opposite directions from that blade" as recited in the claim. Thus, Landrum fails to disclose at least these elements of Claim 20, and therefore Landrum does not anticipate the invention of the claim. Whether more elements of the claim are also

lacking in Landrum may yet be determined after a possible office action that attempts to identify such additional elements in the reference. In any event, the rejection of Claim 20 under 35 USC 102(a) should be withdrawn.

21. If any further claim rejection under 35 USC 102 is raised, applicants respectfully request that a complete listing be provided expressly identifying items by reference number from the cited reference and specifying which element of the claim each item is alleged to anticipate.

22. Based on the foregoing analysis applicants respectfully assert that all Claims 1-21 are in condition for allowance. Therefore, applicants earnestly request withdrawal of all rejections and objections, and allowance of all Claims 1-21 at an early date. If anything further is required to place the entire application in condition for allowance, the examiner is respectfully requested to telephone the undersigned representative.

Respectfully submitted,



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